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Paper No. 36

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In re reissue application of  
Urano, et al.  
Serial No. 09/810,650  
Filed: March 15, 2001  
For: U.S. Patent No. 5,216,135

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REEXAMINATION

In re Urano, et al.  
Reexamination Proceeding  
Control No. 90/004,812  
Filed: October 23, 1997  
For: U.S. Patent No. 5,216,135

: DECISION MERGING  
: REEXAMINATION  
: AND REISSUE  
: PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,216,135 issued to Urano, et al., on June 1, 1993.
2. A request for reexamination of the '135 patent was filed by a third party requester on October 23, 1997, and the resulting reexamination proceeding was assigned Control No. 90/004,812. On December 11, 1997, reexamination was ordered in the '4812 proceeding.
3. A final rejection was mailed in the '4812 proceeding on September 22, 1998, in which claims 1-6 were rejected and claim 7 was indicated to be patentable. A response to the final rejection, accompanied by a notice of appeal, was filed on December 10, 1998, in the '4812 proceeding.
4. The Board of Patent Appeals and Interferences affirmed the rejection of claims 1-6 in the '4812 proceeding on September 24, 1999.
5. Patent owner appealed to the Court of Appeals for the Federal Circuit in the '4812 proceeding on November 19, 1999.
6. The Court of Appeals for the Federal Circuit affirmed the rejection of claims 1-6 in the '4812 proceeding on February 1, 2001.
7. On March 15, 2001, patent owner filed a reissue application which was assigned Application No. 09/810,650.
8. On March 16, 2001, patent owner filed a petition for panel rehearing and for rehearing *en banc* in the '4812 proceeding.
9. On May 8, 2001, on order denying both of the petitions for rehearing was filed in the '4812 proceeding.
10. The mandate of the Court issued on May 15, 2001, in the '4812 proceeding.
11. Notice of the filing of the reissue application was published in the *Official Gazette* on August 7, 2001.
12. A petition to correct the filing receipt was filed in the reissue application on October 2, 2001.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '4812 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '4812 reexamination file shows that the original specification, drawings and patent claims are presently in the reexamination file. Claim 7 was indicated to be patentable, and the final rejection of claims 1-6 was affirmed by the Court of Appeals for the Federal Circuit. The Court mandate issued on May 15, 2001. The reexamination proceeding is awaiting conclusion of the proceeding via the examiner's preparation of a Notice of Intent to Issue Reexamination Certificate.

A review of the reissue (Application No. 09/810,650) prosecution history shows that the reissue application was published in the *Official Gazette* on August 7, 2001. The application is awaiting a first Office action on the merits by the examiner. In the

reissue application, applicant has canceled claims 1-6, amended claim 7 and submitted new claims 8-9 for consideration. Thus, the claims are not identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced, on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND  
REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceeding are *sua sponte* merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 09/810,650, and Control Number 90/004,812. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should comply with the requirements for a response, as set forth below in Part III, the 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs.

### III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for both of the cases, i.e., the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in both files, with each of the two copies bearing a signature. Any such responses must be served on the requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of

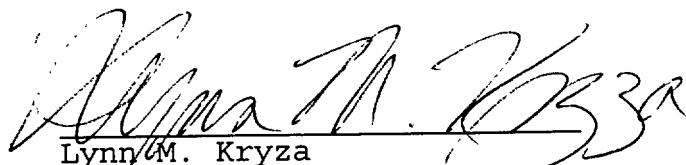
rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution as to the reexamination proceeding.

#### CONCLUSION

1. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.
2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 1600. All further examination should be conducted in accordance with this decision.
3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding.
4. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of:
  - (a) the submission of the housekeeping amendment to place the same amendments in both cases
  - (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.



Lynn M. Kryza  
Patent Special Projects Advisor  
Office of Patent Legal Administration

November 7, 2001